

### **REMARKS/ARGUMENTS**

Entry of the foregoing amendment is respectfully requested for the purpose of placing the application in condition for allowance, or alternatively, in better condition for appeal.

Reconsideration is respectfully requested of the Final Official Action of November 7, 2006, relating to the above-identified application.

A new Declaration claiming the benefit of 8 priority applications filed in Japan is filed herewith. The present application was previously amended to claim the benefit of applicants' earlier application no. 10/797,706, now US Patent 7,023,098. Therefore, the claim for benefit has now been perfected with the filing of the new Declaration.

This application is therefore entitled to the benefit of the filing date of the *Umeno* patent '098 which is no longer available as a reference.

Since this application is a continuation-in-part of applicants' earlier filed copending application No. 10/797,706, now US Patent 7,023,098, and will therefore expire on the same date as the '098 patent, it is not necessary to file a terminal disclaimer.

The application has been amended by replacing the paragraph on page 3 to make it consistent with Claim 1 as requested by the Examiner. Also, page 3 and page 13 have been corrected to be consistent with the previous amendments in Claims 1 and 6, as requested by the Examiner.

Table 1 has been revised to delete examples 8 and 9 to renumber examples 10 to 13 as examples 8 to 11. Former examples 8 and 9 are not included within the scope of amended Claim 1.

It will be noted that Claim 1 has been amended to combine the subject matter of former Claim 5 therein. Claims 4 and 5 have been cancelled and Claim 6 has been made dependent on Claim 1.

The rejection of Claims 1-9 on the ground of non-statutory obviousness type double patenting, as unpatentable over Claims 1-8 of applicants' earlier issued patent, US 7,023,098, taken with the *Gallo* patent (US 6,432,540) and *Iwasaki, et al.*, (US 6,242,110) is traversed and reconsideration is respectfully requested.

Claims 1 to 8 of the earlier issued patent of *Umeno, et al.* do not disclose or suggest the epoxy resin of formula 1 or the phenol resin of formula 2 set forth in Claim 1 of this application. Consequently, there is no basis in the Official Action to allege that the subject matter of this application is obvious in view of Claims 1-8 of the cited patent. In regard to the secondary references, neither of these references show an equivalence between the epoxy or phenol resin defined in Claim 1 of this application and the resins disclosed in Claims 1-8 of applicants' earlier issued patent. The present application is a continuation-in-part of the *Umeno* patent application and, therefore, the *Umeno* patent is not available as a reference.

The rejection of Claims 1 to 9 under 35 U.S.C. § 103(a) as unpatentable over applicants' earlier issued patent, US 7,023,098, in view of *Gallo* and *Iwasaki* is traversed and reconsideration is respectfully requested.

The resin described by applicants' earlier issued patent has sufficient flame retardance that a person having ordinary skill in the art would not be lead to further modify the resin described in that patent. The resin is the main component in the resin composition and changing the resin leads to changes of characteristics in the composition such as flowability.

The rejection of Claims 1 to 9 under 35 U.S.C. § 102(e) as anticipated by *Umeno, et al.* '098 is traversed and reconsideration is respectfully requested. It is noted that *Gallo* and *Iwasaki* are no longer relied on for this rejection as acknowledged in paragraph 4 on page 3 of the Final Action.

This rejection, based on applicants' earlier issued patent, is now moot since the current application is a continuation-in-part thereof and not an application of "another" as required under 35 U.S.C. § 102(e). This means that the *Umeno* '098 patent cannot be cited against this application under 35 U.S.C. § 102(e).

The rejections of Claims 1 to 9 under 35 U.S.C. § 103(a), (1) as unpatentable over the Japanese patent 2003-292730, taken with Japanese patent 3-29352 or (2) as unpatentable in view of *Gallo* and *Iwasaki* and further in view of Japanese patent no. 3-29352, is traversed and reconsideration is respectfully requested.

By amending Claim 1 to specify that the aromatic group is a naphthalene ring, the relevancy of JP '352 has been removed since this reference only discloses catechol, pyrogallol and gallic acid.

The *Gallo* and *Iwasaki* patents do not attribute enhanced flame retardance to the presence of the particular component which is present in applicants' invention. In addition, the resin shown in the Japanese patent application 3-29352 does not teach improving moisture resistance by using an ortho-phenolic compound. Accordingly, there is no motivation for a person skilled in the art to modify the composition of the Japanese document '730 or the compositions of *Gallo* and *Iwasaki*. Withdrawal of the rejection is therefore respectfully requested.

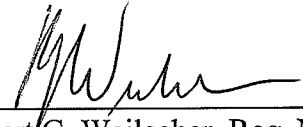
Applicants respectfully submit there is no motivation in the combination of references whereby a person skilled in the art would select the ortho-phenolic compound of the Japanese '352 document for incorporation into the formulations of *Gallo* and *Iwasaki*. In the absence of motivation, the rejection based on obviousness is improper and should be withdrawn.

For reasons set forth above, applicants respectfully request favorable action at the Examiner's earliest convenience.

Respectfully submitted,

SMITH, GAMBRELL & RUSSELL, LLP

By: \_\_\_\_\_

  
Robert G. Weilacher, Reg. No. 20,531

Dated: January 4, 2007  
Suite 3100, Promenade II  
1230 Peachtree Street, N.E.  
Atlanta, Georgia 30309-3592  
Telephone: (404) 815-3593  
Facsimile: (404) 685-6893